

REMARKS/ARGUMENTS

In the Office Action mailed April 28, 2009 (hereinafter, "Office Action"), claims 1-3, 5, 6, 8-12, 14-20, 22, 23 and 25-27 stand rejected under 35 U.S.C. § 102. Claims 4, 7, 13, 21, and 24 stand rejected under 35 U.S.C. § 103. Claims 1, 11 and 17 have been amended.

Applicant respectfully responds to the Office Action.

I. Claims 1-3, 5, 6, 8-12, 14-20, 22, 23 and 25-27 Rejected Under 35 U.S.C. § 102(b)

Claims 1-3, 5, 6, 8-12, 14-20, 22, 23 and 25-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,466,329 to Mukai (hereinafter, "Mukai"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987))). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).) In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Also, under Section 102, the cited reference must disclose all the elements "arranged or combined in the same way as in" the pertinent claims. (*Net MoneyIN, Inc. v. Versign, Inc. et al.* (Case No. 07-1565) (Fed. Cir. Oct. 20, 2008) ("We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.")).

Applicant respectfully submits that the claims at issue are patentably distinct from Mukai. Mukai does not disclose all of the subject matter in these claims.

Claim 1 as amended recites “scanning an image using the scanner” and “obtaining document formatting inputs from a user interface, the document formatting inputs being configurable at the user interface, and wherein the document formatting inputs comprise copy function options.” (Emphasis added.) Support for the amendments to claim 1 is found, for example, at paragraphs [0061], [0067], [0068], [0073] and [0076].

It should be initially noted that Mukai relates to a system using “page identification indicia” on a document to be copied. (Mukai, col. 3, lines 27-29.) “[I]n the presence of a comparison indicia match [found when, for example, the document is placed on a copier], [a] previously recorded electronic image with the same indicia is accessed from the storage arrangement, and the accessed image is either reproduced in hardcopy or transmitted in softcopy.” (Mukai, col. 3, lines 35-39; emphasis added.) For example, Mukai explains:

[I]n executing a copy/print operation, the digital MFP (reproduction apparatus) of this invention preferentially outputs printing data saved in its own external storage rather than the scanned image just read in when the image captured by the scanner is a master page. Thus, the original print quality is maintained by using the master page as an original.

Mukai at col. 7, lines 47-54; emphasis added.

Mukai does not disclose the “identical invention . . . in as complete detail as is contained in . . . claim [1],” as required by Section 102. (MPEP § 2131 (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).) Applicant further submits that the cited reference fails to disclose all the elements “arranged or combined in the same way as in” claim 1, again as required by Section 102, particularly in view of the current amendments to claim 1. (*Net MoneyIN, Inc. v. Versign, Inc. et al.* (Case No. 07-1565) (Fed. Cir. Oct. 20, 2008).)

Mukai states:

[T]he scanned image of the document to be filed is delivered to the document file sender 84 after it has been developed into a bitmap in the image processor 32 and enclosed in PDL format by the image PDL processor 85.

The operator control panel 500 is a module for allowing an operator to input various settings and operation commands for copying, printing, facsimile, and document

filing operations. For instance, device operations including the number of copies, the size of the copies, the degree of enlargement/reduction, duplex printing, and master-page printing, as well as setting of the recipient of a facsimile transmission or file transfer of a document, which may be done interactively on the operator control panel 500.

Makai, col. 9, lines 31-44. This cited excerpt does not disclose the subject matter of claim 1. Simply stating that a control panel allows input of various settings and operations for copying, printing, facsimile, and document filing operations is not tantamount to “obtaining document formatting inputs from a user interface, the document formatting inputs being configurable at the user interface, and wherein the document formatting inputs comprise copy function options” but are used with a scanned image. (Emphasis added.) This portion of Mukai does not associate all of the “device operations including the number of copies, the size of the copies, the degree of enlargement/reduction, duplex printing, and master-page printing, as well as setting of the recipient of a facsimile transmission or file transfer of a document” with “document filing operations.” In Mukai, a number of the enumerated operations clearly relate only to one of “copying, printing, facsimile, and document filing operations.” For example, “setting of the recipient of . . . file transfer of a document file” is clearly unrelated to printing or copying. Likewise, “setting of the recipient of a facsimile transmission” is also clearly unrelated to printing or copying. There is thus no teaching or suggestion in Mukai that “the size of the copies, the degree of enlargement/reduction, duplex printing” relate to “document filing operations.” Mukai simply does not teach “obtaining document formatting inputs from a user interface, the document formatting inputs being configurable at the user interface, and wherein the document formatting inputs comprise copy function options” that are used with a scanned image. Thus, Mukai does not disclose the subject matter of claim 1 in as complete detail as claim 1, as required by Section 102. (MPEP § 2131.) Likewise, Mukai does not disclose the subject matter “arranged and combined,” as in claim 1, again as required by Section 102. (*Net MoneyIN, Inc. v. Versign, Inc. et al.* (Case No. 07-1565) (Fed. Cir. Oct. 20, 2008).)

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Mukai. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Mukai does not disclose all of the subject matter of claim 1.

Claims 2-3, 5, 6 and 8-10 depend directly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 2-3, 5, 6 and 8-10 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claims 11 and 17 include subject matter similar to the subject matter of claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 11 and 17 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claims 12 and 14-16 depend directly from claim 11. Claims 18-20, 22, 23 and 25-27 depend either directly or indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 12, 14-16, 18-20, 22, 23 and 25-27 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

II. Claims 4 and 21 Rejected Under 35 U.S.C. § 103(a)

Claims 4 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukai in view of U.S. Patent Application Publication No. 2002/0114021 to Lavender et al. (hereinafter, "Lavender"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at **37.

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not disclose all of the subject matter in these claims.

Claim 4 depends directly from claim 1. Claim 21 depends indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 4 and 21 be withdrawn.

III. Claims 7, 13 and 24 Rejected Under 35 U.S.C. § 103(a)

Claims 7, 13 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mukai in view of U.S. Patent No. 5,493,634 to Bonk et al. (hereinafter, “Bonk”). This rejection is respectfully traversed.

The standard to establish a *prima facie* case of obviousness is provided above.

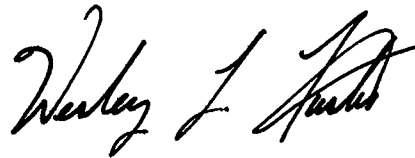
Claim 7 depends directly from claim 1. Claim 13 depends directly from claim 11. Claim 24 depends indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 7, 13 and 24 be withdrawn.

Appl. No. 10/787,365
Amdt. dated July 28, 2009
Reply to Office Action of April 28, 2009

IV. Conclusion

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin". The signature is fluid and cursive, with the first name "Wesley" being the most prominent.

/Wesley L. Austin/

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Date: July 28, 2009

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